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Mailed:
January 25, 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re The Patisserie

Serial No. 76493247

Request for Reconsideration

James C. Wray of Law Offices of James C. Wray for The Patisserie.

Nicholas K.D. Altree, Trademark Examining Attorney, Law Office 108 (Andrew Lawrence, Managing Attorney).

Before Seeherman, Drost and Walsh, Administrative Trademark Judges.

Opinion by Walsh, Administrative Trademark Judge:

On July 5, 2005, the Board affirmed the examining attorney's refusal to register the mark PARADISE LAVOSH in standard-character form for "baked cracker bread and baked Armenian bread" under Section 2(d) of the Act, 15 U.S.C. § 1052(d), based on a likelihood of confusion with the mark in Reg. No. 2,404,157, PARADISE, also in standard-character

form, for "cakes." The Patisserie (applicant) has requested reconsideration of that decision.¹ Specifically, applicant asks we reconsider the following: "(1) the original Examining Attorney's finding of registrability after a search in the Examiner's Amendment dated August 13, 2002, and (2) other registrations and uses of 'Paradise' for goods more similar to cakes than cracker bread. For example, in the first action the Examining Attorney also cited PARADISE DONUTS."

Applicant also requests that we consider a list of 33 marks which applicant states it cited in its first response with a statement that they are "all associated with food."

Applicant adds, "All of the evidence in the case should be considered. When all of the evidence in the case is considered, it is clear that the protection of PARADISE for cakes is narrow and limited only to cakes."

We addressed Applicant's first point, that is, the alleged "finding of registrability" in the Examiner's Amendment of August 13, 2002, in our opinion. In footnote 2 of our opinion, we refer to two instances (both

¹ Applicant filed the request on July 28, 2005, and identified the paper as a "REQUEST FOR REHEARING." It is apparent that applicant intended to request reconsideration under Trademark Rule 2.144 and we are treating it as such a request. The Board regrets the delay in responding to this request.

Examiner's Amendments), including the one referenced by applicant, in which the examining attorney included the standard search clause indicating that no conflicting marks had been found. In both instances it appears that the inclusion of the standard search clause was inadvertent. It is crystal clear when one looks at the entire record that the subsequent refusal, which ultimately became the subject of this appeal, superseded the statement in the August 13, 2002, Examiner's Amendment that no conflicting marks had been found.

During the examination phase the examining attorney has the authority to issue a refusal under Section 2(d) of the Trademark Act, if appropriate, whether or not an earlier action stated that no conflicting marks had been found. In fact, Office procedures obligate the examining attorney to do so in a case such as this, "If in the first action the examining attorney inadvertently failed to refuse registration on a clearly applicable ground or to make a necessary requirement, the examining attorney must take appropriate action to correct the inadvertent error in a subsequent action." TMEP § 706 (4th ed. 2005). Accordingly, we find no reason on this basis to alter our decision.

Secondly, applicant asks that we reconsider our decision because of, "other registrations and uses of 'Paradise' for goods more similar to cakes than cracker bread." Applicant first points to "PARADISE DONUTS," as an example. In footnote 3 of our opinion we discussed "PARADISE DONUTS" specifically. We concluded that the PARADISE DONUTS mark, which, according to the record, was merely the subject of a pending application, failed to show that "PARADISE" is a weak mark.

Applicant apparently also relies on the 33 marks listed at page 2 of its request as examples of other "registrations and uses of 'PARADISE.'" These marks were in a list of PTO records applicant provided in its initial response to the Section 2(d) refusal. Beginning on page 14 of our opinion under the heading "Similar Marks in Use on Similar Goods" we discussed this evidence, as well as other similar evidence of record. With regard to the lists which included these 33 marks, we stated:

Applicant provided a listing of those registrations; the listing included only the application serial numbers, registration numbers, the marks and the status, that is, an indication as to whether the record was "live" or "dead." "Mere listings of registrations or copies of private company search reports, are not sufficient to make the registrations of record." TBMP § 1208.02 (2d ed. rev. 2004)(citations omitted). The examining attorney has not explicitly objected to these. However, as a practical matter, because these records do not include

any information with regard to the goods and services, nor any ownership information, they are of extremely limited probative value.

As indicated here, we did consider this evidence and found that it had "extremely limited probative value."

Finally, applicant indicates that "all of the evidence in the case" should be considered. We did consider all of the evidence in the case in reaching our decision, as noted in the original decision and as we reiterate now.

In conclusion, we have considered all of applicant's arguments but we find no basis to change our decision. Applicant's request for reconsideration is denied. The decision, dated July 5, 2005, stands.